

Remarks:

In the January 13, 2006, Office Action, Claims 1-24 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Eicher, III (U.S. Patent No. 5,340,095) in view of Schwörer (U.S. Patent No. 5,653,415) and Smith (Re. 32,815).

Applicant has made extensive amendments to independent Claims 1, 10, and 24 to better point out and distinctly claim the subject matter which Applicant regards as his invention. All three of the independent claims pending in the present patent application, namely Claims 1, 9, 10, and 24, are believed to patentably distinguishable over the prior art.

Applicant's invention is a device for setting a door frame in position before adjacent walls are built and for maintaining the dimensions of the door frame during the building of the adjacent walls. The invention includes two head plates with facing edges which are designed to fit against the opposite sidewalls of a door frame. The head plates are attached to arms which adjustably engage to provide one of a plurality of predetermined widths between the facing edges, thus allowing the distance between the sidewalls to be set with precision as the door frame is installed. The apparatus is adjustable, lightweight, and easily portable by hand from worksite to worksite.

The only potentially relevant reference is the Eicher, III reference, which discloses a door buck spreader. Those skilled in the art will at once realize that a door buck spreader is completely different from Applicant's invention, which is a device for setting the distance between the sidewalls in a door frame. A door buck spreader is not used

with a door frame at all. Rather, a door buck spreader is used in the installation of a door buck, which is the rough frame of the door. A door buck is made of heavy materials, provides the structural support for the door opening, and is the interface between the door opening and the rest of the building. A door frame, on the other hand, is installed into a door buck, and a door frame is typically both smaller and lighter since it does not have to provide structural support for the door opening in the building.

The Eicher, III reference does not teach, or in any way suggest, the use of the device for any other purpose than as a door buck spreader, which functions to keep the bottoms of the door buck components on opposite sides of the opening spaced apart. Door bucks are frequently not precise in their dimensions because they need not be. On the other hand, door frames must be precise in their dimensions since otherwise a door installed in the door frame will not hang or fit properly (or open and close properly as well). The device taught by the Eicher, III reference is large, heavy, expensive, and functions in an entirely different manner than the present invention. It is fastened to the bottoms of the door buck, and it does not have the precise adjustment of dimension which is claimed by the present invention. It functions to spread the bottoms of the door buck.

By adjusting the nut 16 of the device taught in the Eicher, III reference, the width of the devices is infinitely adjustable. The device of the Eicher, III reference is thus incapable of adjustment in the manner claimed by Applicant's invention. In fact, in order to operate, the device of the Eicher, III reference must be adjusted in the infinitely adjustable manner it uses in order to spread the bottom ends of the door buck apart.

Consider if it was adjustable in the manner taught by Applicant's invention -- it quite simply would not work. The adjustment mechanism used by the device of the Eicher, III reference is thus required in order for it to function.

The other references cited in the January 13, 2006, Office Action have nothing whatsoever to do with either Applicant's invention of the device of the Eicher, III reference. The Schwörer reference is an adjustable height support for holding shutters or the like off of the ground as they are being installed. It has no relationship whatsoever to door frames (or door bucks) or to the installation of door frames (or door bucks). One skilled in the art of Applicant's invention would never look to the Schwörer reference to combine with the device of the Eicher, III reference.

The Smith reference is an adjustable crutch which has an adjustment mechanism which may be used to adjust the height of a crutch. It also has no relationship whatsoever to door frames (or door bucks) or to the installation of door frames (or door bucks). One skilled in the art of Applicant's invention would never look to the Smith reference to combine with the device of the Eicher, III reference.

Further, if the adjustment mechanism of either the Schwörer reference or the Smith reference were added to the device of the Eicher, III reference, the function of the device of the Eicher, III device would be destroyed. The adjustment mechanisms of the Schwörer reference and the Smith reference are incapable of performing the spreading function of the device of the Eicher, III reference. Thus, one skilled in the art would not make the combination proposed in the January 13, 2006, Office Action.

Still further, Applicant can see no reason other than hindsight that one skilled in the art would have combined the three references used to reject the claims. Applicant believes that it is clear that the January 13, 2006, Office Action used Applicant's claims as a recipe list to facilitate a hindsight-based reconstruction of Applicant's invention.

With respect to an obviousness rejection based upon a such a combination of references, the Court of Appeals for the Federal Circuit has stated that "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 2003); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements.") Since it is often possible to find every element of a claimed invention in the prior art, if identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would issue. However, the Court of Appeals for the Federal Circuit has stated that "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." Ecolchem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1371, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

The recitation of the three references in the January 13, 2006, Office Action which disclose some of the elements of the claims without any reason that one skilled in the art would make such a combination constitutes the use of hindsight and is per se improper. As stated by the Court of Appeals for the Federal Circuit, "Combining prior art references

without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). This clear and inappropriate use of hindsight knowledge to establish obviousness is impermissible.


Where is the reason cited in the January 13, 2006, Office Action justifying the combination? Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)" Yet nowhere in the January 13, 2006, Office Action is there a single word identifying any teaching, suggestion, or motivation in the cited references justifying the combination. Further, there is no attempt in the January 13, 2006, Office Action to ascertain the knowledge generally available to one of ordinary skill in the art.

When no teaching, suggestion, or motivation supporting a combination of references exists in the references that are being combined, and there is a complete absence of any finding related to the knowledge generally available to one of ordinary skill in the art, the rejection is exposed for what it is -- a completely unsupportable combination which is based entirely upon the use of hindsight and the use of Applicant's claims as a blueprint to go and search for the elements of the claims -- a clearly

inappropriate and impermissible use of hindsight knowledge. Applicant asserts that since there is no such teaching or motivation supporting the position taken by the Section 103(a) rejections, the rejection of these claims is improper and must be reversed. Accordingly, Applicant respectfully solicits the allowance of these claims.

In conclusion, Applicant believes that the present patent application with Claims 1-5, 7-12, and 14-26 as amended are patentable at this time. These claims remain pending following entry of this Amendment A, and the patent application with Claims 1-5, 7-12, and 14-26 is believed to be in condition for allowance at this time. Applicant respectfully requests entry of this Amendment A, and an early and favorable consideration of the claimed subject matter as amended is solicited. Should the Examiner believe that the prosecution of the patent application can be so expedited, the Examiner is requested to call Applicant's undersigned attorney at the number listed below.

Respectfully submitted:

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